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EXAMINER

ENG, DAVID Y

ART UNIT	PAPER NUMBER
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2155

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/576,093
Filing Date: May 22, 2000
Appellant(s): HENRY ET AL.

David Rodack
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 1, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

Appellants' claimed invention is a cache memory (104, Figure 2) for storing and updating (steps 304, 306 and 308, Figure 3) an address book of a sending device shown in Figure 1. The sending device contains a keyboard 14 for inputting a sending address, and a cache memory 104 for storing an address book. In response to entering of an address (sending address), the cache memory is searched (step 304) for the entered address to determine whether the address was previously stored in the cache. If it is not found in the cache, the newly entered address is then stored (step 308) in the cache (independent claims 1, 9, 15 and 20). If the recipient's address is found (step

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306) in the cache, the stored version of the recipient's address and the entered (by sender) version are both presented to the user for selection (independent claim 9).

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 5-8, 15-24 and 30 stand or fall together with claim 1 because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. Further, scope of independent claims 15 and 20 is the same as independent claim 1. See 37 CFR 1.192(c)(7).

The rejection of claims 10 and 12-14 stand or fall together with claim 9 because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,405,243	Nielsen	6-2002
6,427,164	Reilly	7-2002

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 5-10, 12-24 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielson (USP 6,405,243) in view of Reilly (USP 6,427,164).

Independent claim 9 is selected in the rejection as an exemplary because it includes all the limitations of independent claims 1, 15 and 20.

Teaching of Nielson (6,405,243):

Attention of the Board is respectfully directed to Figures 1 and 5 and lines 6-25 of column 7 in Neilsen. Neilsen taught a sending device (sender computer 101 of Figure 1) having a memory (111 of Figure 1) for storing an email program. In Figure 5 and in lines 5-25 of column 7, Neilsen taught how a sender's address book is updated with a new email address of a recipient (Appellants' claims 1, 9, 15 and 20). If the old email address was in the sender's address book, then the sender's email program also updates the sender's address book file. If the recipient's old email address was not in the sender's address book then it is added to the sender's address book (lines 10-14 of column 7 in Neilsen).

9. A method for processing sending information (Figure 5 in Nielsen) in a sending device (101 in Figure 1), comprising:

receiving an entry input (BEGIN in Figure 5, the entry input is the entry which is being searched in step 503) by a user (sender in Nielsen) at the sending device (sending computer 101 of Figure 1), the entry comprising sending information (new email address of the recipient in lines 9-10 of column 7), and determining the identity of the user from the entry;

receiving the sending information entered by the user that identifies a destination (new email address) to which information is to be sent by the sending device (this step

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is a repetitive recitation of previous step and therefore does not contain any new limitation);

responsive to the entry, cross-referencing (searching step 503 in Figure 5 and lines 10-14 and 18-23 of column 7) the sending information (new email address of the recipient) entered by the user (sender) with a contacts database (sender's address book) that contains recipient sending information (old email address of the recipient) of the user (sender) to determine if the user-entered sending information (new email address of the recipient) matches sending information (old email address of the recipient stored in the sender's address book) saved for that user, wherein the contacts database is stored within memory of the sending device (In lines 6-14 of column 7, Nielsen taught that the sender's address book being updated by sender' email program stored in memory 111 as shown in Figure 1. It is therefore reasonable to conclude that the Nielsen's address book is stored in memory 111 of sending device 101);

providing previously saved sending information to the user as a selection option if sending information entered by the user matches the previously saved sending information (in lines 61-66 of column 6, Nielsen also allows the sender to select either the old or the new email address); and

automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved (lines 12-15 and lines 19-21 of column 7 and step 507 of Figure 5).

Although Nielsen taught in lines 6-14 of column 7 that the sender's address book being updated by sender' email program stored in memory 111 as shown in Figure 1,

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Nielsen does not explicitly state that the sender address book is stored in the sender's sending device. Reilly teaches a sender's address book which is stored in a sending device 110 (see lines 54-58 of column 9 in Reilly). From the teaching of Reilly, it would have been obvious to a person of ordinary skill in the art to store a sender's address book in a sending device such that the address book can be used by the sending machine.

Details of the rejection of dependent claims have already been set forth in the Final Office action. Since all pending dependent claims stand or fall together with independent claims because Appellants did not provide separate arguments, details of the rejections of pending dependent claims would not present in the Answer. Details of the rejection of all pending dependent claims are incorporated herein by reference to the Final Office action.

(11) *Response to Argument*

Arguments directed to independent claims 1, 9, 15 and 20 are the same because scopes of the claims are the same. Claim 9 is most comprehensive and therefore is selected to response to the arguments.

On page 14 of the Appeal Brief, Appellants argued that neither Nielson nor Reilly teach the claim limitations (a) "responsive to the entry, cross-referencing the sending information entered by the user with a contacts database," (b) "wherein the contacts database is stored within memory of the sending device," or (c) "automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved," as recited in claim 9. The

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Examiner disagrees. As demonstrated in the section 103 Rejection above, Nielsen and Reilly teach all the limitations recited in claim 9.

With respect to (a) "responsive to the entry, cross-referencing the sending information entered by the user with a contacts database", attention of the Board is respectfully directed to Nielsen's description in lines 5-25 of column 7. In the excerpt, Nielsen clearly teaches that the procedure shown in Figure 5 is for updating an entry stored in the sender's personal address book in response to the entering of a new email address of the recipient. This clearly meets the limitation of "responsive to the entry" recited in claim 9. Step 503 of Figure 5 is for searching for recipient's old email address in the sender's address book. Step 503 clearly meets the limitation of "cross-referencing the sending information entered by the user with a contacts database (address book)". Appellants fail to provide any explanation as to why the Examiner's interpretation of Nielsen is in error.

With respect to (b) "wherein the contacts database is stored within memory of the sending device", this limitation is suggested by Nielsen and is positively taught by Reilly. Attention of the Board is respectfully directed to lines 6-14 of column 7 in Nielsen. Nielsen implicitly teaches that the sender's address book being updated by sender's email program (Figure 5) is stored in memory 111 of sender's computer 101 as shown in Figure 1. However, Nielsen does not explicitly state that the sender address book is stored in the sender's sending device. Reilly teaches a sender's address book which is stored in a sending device 110 (see lines 54-58 of column 9 in Reilly). From the teaching of Reilly, it would have been obvious to a person of ordinary skill in the art to

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store a sender's address book in a sending device such that the address book can be used by the sending machine. Appellants fail to provide any arguments as to why the combination of Nielsen and Reilly is improper and how the combination would render the invention in Nielsen unsatisfactory for its intended purpose. As clearly disclosed in lines 5-25 of column 7, the purpose of Figure 5 in Nielsen's is to update sender's address book stored in sender's computer. Appellations further fail to explain how maintaining the database of Nielsen at the sending device would cause error messages to occur when email addresses are changed. Note that Nielsen's invention as described in the patent is held operative.

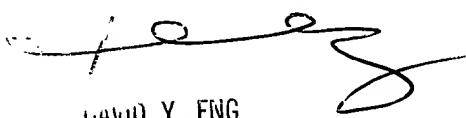
With respect to (c) "automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved", attention of the Board is respectfully directed to lines 12-15 and lines 19-21 of column 7 and step 507 of Figure 5. The excerpts clearly teach that if the recipient's address entered by the sender is not found in the sender's address book, the address entered by the sender is added to the address book because it is a new address. The address entered by the sender is considered as new address because it never has been stored in the address book. The new address therefore is added to the address

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book. That is exactly what is recited in the last paragraph of independent claim 9.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,




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December 20, 2004

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